

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-20 are currently pending. No claims have been amended herewith.

In the outstanding Office Action, Claims 19 and 20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and Claims 1-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,789,078 to Saitou et al. (hereinafter “the ‘078 patent”).

Applicants respectfully traverse the rejection of Claims 19 and 20 as being directed to non-statutory subject matter. As stated in the previous response, Applicants note that M.P.E.P. § 2106 states that “a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature.” See also, Ex parte Rice¹, in which the Board stated “...we agree that signals do not become unpatentable subject matter just because of their transitory and informal nature.” Further, Applicants note that numerous patents have issued containing “signal” claims. Accordingly, Applicants respectfully submit that this rejection should be withdrawn and that Claims 19 and 20 are directed to statutory subject matter under 35 U.S.C. § 101.

The ‘078 patent, which is asserted against all pending claims in the present application, has an effective reference date under 35 U.S.C. § 102(e) of June 15, 2001, which corresponds to the actual U.S. filing date of the ‘078 patent. The actual U.S. filing date of the present application is January 29, 2002. However, the present application claims priority under 35 U.S.C. § 119 to Japanese Patent Application No. 2001-020551, filed January 29, 2001.² Therefore, in order to perfect Applicant’s claim to foreign priority in the present

¹ BPAI, February, 2003. . .

² This claim for foreign priority was acknowledged in the outstanding Office Action.

application, submitted herewith is a certified English translation of Japanese Patent Application No. 2001-020551. Thus, Applicants respectfully submit that the '078 patent does not qualify as a *prima facie* prior art reference against the claims in the present application. Accordingly, the rejection of the claims under 35 U.S.C. § 102 in the outstanding Office Action should be withdrawn.

In addition, Applicants note that Claim 1 is directed to a server device, comprising, *inter alia*: (1) a communication section which sends and receives predetermined information to and from at least one user terminal through a communication network; (2) an input-form sender which sends input form information for inputting ID information for identifying at least one user and a predetermined ID form; (3) an ID-information receiver which receives the ID information from the at least one user terminal through the communications section; (4) an information acquirer which acquires the user information corresponding to the at least one user from the user information storage section; (5) a member-form sender which sets the user information acquired by the information acquirer in member-form information used for inputting member information to generate thereby member form information having at least part of the member form information set therein, and sends the generated member form information to the at least one user terminal through the communications section; and (6) a member information receiver which receives the member information sent from the at least one user terminal.

Regarding the rejection of Claim 1 as anticipated by the '078 patent, the '078 patent is directed to a member information registration method and system for users accessing a web server from a personal computer or from a mobile telephone. As shown in Figure 1, the '078 patent discloses that a user may register using a terminal device 20 or a mobile device 21, and then later access the server using the terminal device 20 or the mobile telephone 21, regardless of which device was used to register. However, Applicants respectfully submit

that the '078 patent fails to disclose a member form sender which sets the user information acquired by an information acquirer in member form information used for inputting member information to generate thereby member form information having at least part of the information set therein, as recited in Claim 1. Rather, the '078 patent merely discloses two methods by which a user may enter a member ID, password, email address, name, address, and payment information. Accordingly, for this additional reason, Applicants respectfully submit that Claim 1 patentably defines over the '078 patent.

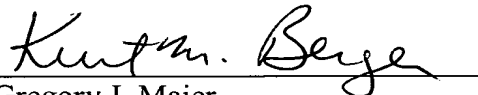
Independent Claims 2, 9, 10, and 17-20 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that Claims 2, 9, 10, and 17-20 (and all associated dependent claims) patentably define over the '078 patent.

Thus, it is respectfully submitted that independent Claims 1, 2, 9, 10, and 17-20 (and all associated dependent claims) patentably define over the '078 patent.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully submitted.

Respectfully submitted,

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